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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/598,395	06/20/2000	Michael J. Natan	PSU 00 2182A	6068

25871 7590 05/23/2003

SWANSON & BRATSCHE L.L.C.  
1745 SHEA CENTER DRIVE  
SUITE 330  
HIGHLANDS RANCH, CO 80129

EXAMINER

MARSCHER, ARDIN H

ART UNIT	PAPER NUMBER
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1631

#26

DATE MAILED: 05/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/598,395

Applicant(s)

Natan et al.

Examiner

Ardin Marschel

Art Unit

1631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Jan 24, 2003
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-87 is/are pending in the application.
- 4a) Of the above, claim(s) 37-86 is/are withdrawn from consideration
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-36, and 87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-5 and 7-87 are subject to restriction and/or election requirement

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) 3 sheets 6) ☐ Other:

Applicants' arguments, filed 1/24/03, have been fully considered but they are not deemed to be persuasive. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### **CLAIM RENUMBERING**

The numbering of claims is not accordance with 37 C.F.R. 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 CFR 1.121(b), they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 37 has been renumbered as claim 87.

#### **VAGUENESS AND INDEFINITENESS**

Claims 1-5, 7-36, and 87 are rejected, as discussed below, under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 1, the conjugated wording limitation "template-separated" is cited as describing the therein claimed particle. This limitation indicates that a template was utilized

from which the particle is separated in its preparation. It is noted also that the claims are directed to a particle which is deemed as thus claiming a composition or product. The claims under examination therefore are reasonably interpreted as product by process claims, the process being characterized by the limitation "template-separated". Patentable weight is given to a process in such a claim, if the process actually limits the product subject matter. If this "template-separated" limitation is meant to limit the subject matter of the instant claims, the metes and bounds of such a limitation are unclear regarding what is meant by "template". The limitation word "separated" is deemed reasonably clear. It is additionally noted that various templates are described in the instant specification, notably porous materials into which the particles are formed via deposition of material(s), followed by removal of the template by template dissolution or other means. The preparation of particles for the instant invention is described, for example, on page 16, lines 3-4, as by "a variety of processes". A template or mold is described on page 16, lines 5-10, with segment formation via electrodeposition etc. in lines 10-16. A review of the instant specification has not, however, revealed a definition of the metes and bounds of the limitation "template" as being limited to porous template material into which material is deposited to prepare a particle of the instant invention, albeit

this is what is exemplified. Given the generic directive for particle preparation on page 16, lines 3-4, as being directed to "a variety of processes" and no definition for what is meant by template, someone wishing to interpret the instant invention would reasonably view a template as anything which shapes or forms a particle of the instant invention, such as a cutting tool, for example, as utilized in Lee (P/N 4,053,433). Since a particle must be prepared with some shape, even if random in nature, a template seems to be inclusive of a variety of such materials without a clear definition of any particular metes and bounds thereof. For example, does the template have a requirement as to the number of sides of the prepared particle that the template is configured to shape. A pore may be viewed as having cylindrical sides and a top and bottom. The template, being a pore, would thus define the side shaping and the bottom shaping, but not the top. Would, therefore, a template also only shape one side, such as being a cutter? What about extrusion methods where only the sides are shaped with the top and bottom undefined until chopped in some way. Thus the metes and bounds of what is meant by "template-separated" are vague and indefinite and unclear whether it does not does not limit the product as claimed. Clarification via clearer claim wording is requested. This rejection is necessitated by amendment.

**PRIOR ART**

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. § 103, the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of potential 35 U.S.C. § 102(f) or (g) prior art under 35 U.S.C. § 103(a).

Claims 1-5, 7-12, 14, 18-23, 27, 29-34, and 87 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lee (P/N 4,053,433).

This rejection is maintained and reiterated from the previous office action, mailed 7/24/03, and as necessitated by amendment regarding newly added claim 87. Applicants firstly argue this rejection regarding the newly submitted claim wording directed to "template-separated". As noted above the metes and bounds of what is meant by a template are unclear. Thus, the

cutter methodology of Lee remains reasonably to produce a type of template-separated particle as instantly claimed. Applicants also argue regarding functionalization as being a surface attachment requirement in the instant claims. In response color codes in Lee include surface layering as noted in column 3 of the reference as well as the generic tagging of a production substance as described in the abstract and as the basic material being tagged in the entire description of Lee.

The non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78(d).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-5 and 7-36 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of copending application Serial No. 09/677,198. This rejection is maintained and reiterated from the previous office action, mailed 7/24/02.

Applicants argue that the copending application Serial Number 09/677,198 has been subject to a restriction/election requirement and that claims 1-36 of said copending application have been withdrawn, thus making this rejection improper. In response, consideration of said copending application revealed that claim 1-36 have been withdrawn, but are still pending. Still pending claims are subject to double patenting issues such as this one, even though they have been withdrawn from consideration. Therefore, this rejection is proper and is maintained.

This is a *provisional* obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

No claim is allowed.

Applicants' amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See M.P.E.P. § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

This application contains claims 37-86 drawn to an invention



non-elected without traverse in Paper No. 10, filed 10/9/01. A complete response to the final rejection must include cancellation of non-elected claims or other appropriate action (37 C.F.R. § 1.144) M.P.E.P. § 821.01.

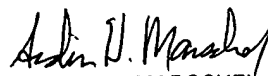
Papers related to this application may be submitted to Technical Center 1600 by facsimile transmission. Papers should be faxed to Technical Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993) (See 37 CFR § 1.6(d)). The CM1 Fax Center number is either (703)308-4242 or (703)305-3014.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ardin Marschel, Ph.D., whose telephone number is (703)308-3894. The examiner can normally be reached on Monday-Friday from 8 A.M. to 4 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, Ph.D., can be reached on (703)308-4028.

Any inquiry of a general nature or relating to the status of this application should be directed to Legal Instrument Examiner, Tina Plunkett, whose telephone number is (703)305-3524 or to the Technical Center receptionist whose telephone number is (703) 308-0196.

May 22, 2003

  
ARDIN H. MARSCHEL  
PRIMARY EXAMINER